

REMARKS

In response to the Final Action mailed July 17, 2009, Applicants enclose an amendment and supplemental information disclosure statement. By virtue of the filing of a RCE submitted herewith, the enclosed amendment and supplemental information disclosure statement are entered into the application. Favorable consideration of this application is respectfully requested in view of the above amendment and the following remarks.

Claims 1, 4-7, 9-13 and 16 are pending in the application. Claim 16 has been cancelled without prejudice.

Claim 16 has been rejected under 35 U.S.C. §112, first paragraph, based on alleged lack of enablement. In response, to facilitate prosecution claim 16 has been cancelled without prejudice. Applicants reserve the right to file a continuation directed to claim 16.

In view of the above, withdrawal of the rejection of claim 16 under 35 U.S.C. §112, first paragraph, is respectfully requested.

Claims 1, 4-7, 9-13 and 16 have been provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 4, 7, 10-21, and 23 of copending application no. 10/482, 707 (the '707 application). In particular, the Examiner asserts that while the conflicting claims are not identical, they are not patentably distinct from each other because the claims overlap in scope substantially and cover the same compounds. The Examiner also asserts that the wording is only slightly different and that the '707 application is broader but where X is NH and Y is CO the compounds of the instant case are produced. The Examiner also asserts that some of the same species are present in both applications. The Examiner also asserts that the compounds of the present claims are analogs of old compounds. The Examiner also asserts that one of ordinary skill would be motivated to make the compounds of the invention because he would expect the compound to have similar properties. The Examiner also cites to the case *In re Grabiak*, 226 USPQ 870, for the proposition that "when chemical compounds have very close structural similarities and similar utilities, without more, a prima case may be made", *In re Deuel*, 35 USPQ2d 1210, "a known

compound may suggest its **analogs** or isomers, either geometric isomers (*cis v. trans*) or position isomers (emphasis added) (*e.g., ortho v. para*).”

Applicants respectfully traverse this rejection and submit that the claimed compounds are not made obvious by the claims of the ‘707 application.

With respect to the Examiner’s assertions that the claims overlap in scope substantially and cover the same compounds, it is asserted that while the ‘707 application claims compounds which share a similar core, there is absolutely no overlap between the presently claimed compounds and the claimed compounds of the ‘707 application. For there to be overlap, the presently claimed compounds would have to fall within the scope of the claimed compounds of the ‘707 application. The presently claimed compounds do not fall within the scope of the claimed compounds of the ‘707 application and are indeed very different from the claimed compounds of the ‘707 application for the following reason. In the presently claimed compounds, when R⁴ is hydrogen, then R⁵ is neither OH or (1-4C)alkoxy, and thus in this situation R⁵ is **only R⁷**, i.e., amino, (di)(1-4C)alkylamino, (2-5C)heteroarylcarbonylamino, (2-5C)heteroarylcarbonyloxy, R⁸-(2-4)alkoxy, R⁹-methylamino or R⁹-methoxy, all of which differ substantially from the possible substituents, i.e., H, (1-4C) alkyl, or (1-4C)alkoxy, disclosed as R⁷ in the ‘707 application. There is no teaching or suggestion in the ‘707 application to modify the R⁷ substituent, i.e., H, (1-4C) alkyl, or (1-4C)alkoxy, to the substituents recited for R⁷ in the presently claimed invention, i.e., amino, (di)(1-4C)alkylamino, (2-5C)heteroarylcarbonylamino, (2-5C)heteroarylcarbonyloxy, R⁸-(2-4) alkoxy, R⁹-methylamino or R⁹-methoxy. It is further submitted that by the Examiner’s statement that “a known compound may suggest its **analogs** or isomers”, the Examiner means that any modification to recite a different substituent can be made on a known compound and such modification resulting in an **analog** would be obvious. While arguably an adjacent homolog or positional isomer of a compound may be *prima facie* obvious, Applicants request the Examiner to provide a recent pharmaceutical compound case which stands for the proposition that **any** modification to a compound resulting in an **analog** of a known compound is *prima facie* obvious. Accordingly, it is believed that the claimed invention is nonobvious over claim 4, 7, 10-21, and 23 of the ‘707 application.

In view of the above, withdrawal of the rejection of claims 1, 4-7, 9-13 and 16 on the ground of obviousness-type double patenting as being unpatentable over the claims 4, 7, 10-21, and 23 of the '707 application is respectfully requested.

Claims 1, 4-7, 9-13 and 16 have been provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-8, and 11 of copending application no. 10/540, 335 (the '335 application). The Examiner asserts that although the conflicting claims are not identical, they are not patentably distinct from each other because the claims overlap in scope substantially and cover the same compounds. The Examiner also asserts that the wording is only slightly different and the '335 application is narrower but the genus produced is nearly identical. The Examiner also asserts that some of the same species are present in both applications.

Applicants respectfully traverse this rejection and submit that the presently claimed compounds are not rendered obvious by the claimed compounds of the '335 application. The presently claimed compounds are very different from the claimed compounds of the '335 application. The presently claimed compounds require a substituent R5, which is not encompassed within the claimed compounds of the '335 application. In addition, the presently claimed compounds at position R3 differ from the claimed compounds of the '335 application. R3 of the presently claimed compounds can be H, hydroxyl, (1-4C)alkoxy whereas the claimed compounds in the '335 application require alkoxy substituted with other functional groups or groups other than alkoxy. The '335 application does not teach or fairly suggest modification of the presently claimed compounds at R5 or R3. The aforementioned differences between the claimed compounds of the present application and the '335 application are also discussed on page 3 of the Notice of Allowance for the '335 application, wherein the Examiner in charge of the '335 application withdrew the obviousness-type double patenting rejection of the claimed compounds of the '335 application over the claimed compounds of the present application (see attached IDS, Notice of Allowance dated August 14, 2009 in the '335 application.).

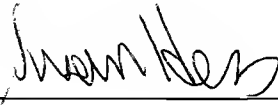
In view of the above, withdrawal of the rejection of claims 1, 4-7, and 9-13 on the ground of obviousness-type double patenting over claims 1-8 and 11 of the '335 application is respectfully requested.

If the Examiner believes a telephone conference would be of value, she is requested to call the undersigned at the number listed below.

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Respectfully submitted,

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